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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,327	09/24/2003	Toshiki Taguchi	Q77655	2308

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT PAPER NUMBER

1755

DATE MAILED: 03/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/668,327

Applicant(s)

TAGUCHI, TOSHIKI

Examiner

Helene Klemanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/2/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

1. The references cited in the Search Report dated November 20, 2003 have been considered.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13 and 14 of copending Application No. 10/806,424. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application overlap said patent claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

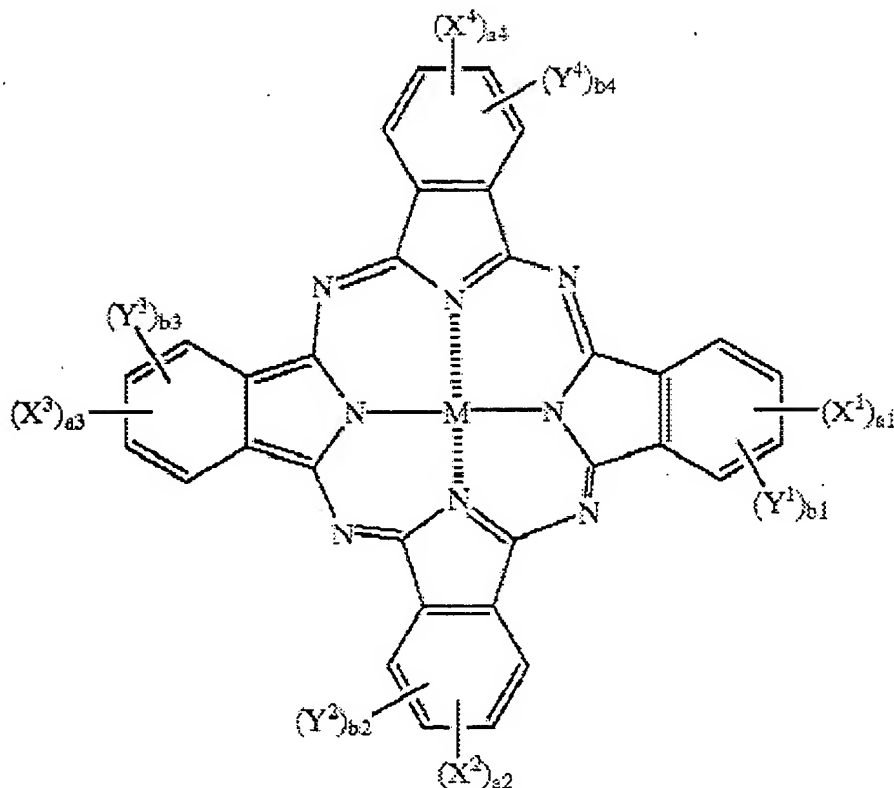
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamanouchi et al. (US 2002/0107301).

Yamanouchi et al. teach an ink composition for ink jet recording comprising a coloring particulate dispersion wherein the dispersion contains a hydrophobic organic solvent and an oil soluble dye of the formula



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wherein X^1 - X^4 each independently represent $-\text{SOZ}^1$, $-\text{SO}_2\text{Z}^1$ and $-\text{SO}_2\text{NR}^{21}\text{R}^{22}$; Z^1 represents an substituted or unsubstituted alkyl, cycloalkyl, alkenyl, aralkyl, aryl or heterocyclic group; R^{21} and R^{22} each independently represent H or substituted or unsubstituted alkyl, cycloalkyl, alkenyl, aralkyl, aryl or heterocyclic group; Y^1 - Y^4 each independently represent H, halogen atoms or alkyl, cycloalkyl, alkenyl, aralkyl, aryl, heterocyclic etc. groups and a^1 - a^4 and b^1 - b^4 each represent an integer of 0-4 wherein $a^1+a^2+a^3+a^4$ is no less than 2. Yamanouchi et al. further teach that when the coloring particulate dispersion contains coarse particles (i.e. inorganic cations), printing ability may be decreased. Preferably, the amount of coarse particles is low. The coarse particles may be removed by centrifugal separation or filtration. See para. 0016, paras. 0175-0179, para. 0186, paras. 0190-0195, paras. 0207-0214, dyes (C-101) to (C-120), paras. 0312-0314, example 1, Table 13, Table 19; Ink Sets 202-209 and claims 18, 22 and 25. The ink composition as taught by Yamanouchi et al. appears to anticipate the present claims.

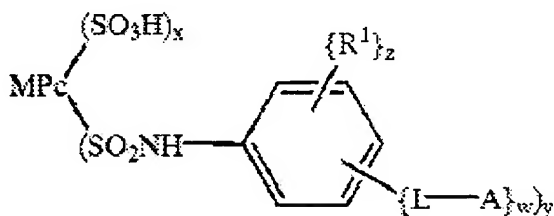
The only limitation in the claims not found by the examiner is the total amount of a cation in the ink. However, this limitation is considered inherent because there does not appear to be any reason why the cited reference would not contain an ink composition with applicants claimed amount of cations.

It is the examiners position that by reducing the amount of coarse particles in the ink composition of Yamanouchi et al. by centrifugal separation or filtration the amount of the cations in the ink composition of Yamanouchi et al. would also be reduced as claimed by applicants.

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Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Kenworthy et al.

Kenworthy et al. teach an ink jet ink composition comprising 70-99.9 parts by weight of a liquid medium and 0.01-30 parts by weight of a dye of the formula



wherein M represents a metal or H; Pc represents a phthalocyanine nucleus; L represents an optionally substituted C₁₋₃₀ hydrocarbyl group; A represents an amino or an optionally substituted C₁₋₃₀ hydrocarbyl group comprising at least one protonable nitrogen with the proviso that A does not comprise an alkyl group substituted by at least one of a hydroxy, carboxy or sulfo group; R¹ represents an optional substituent or an optionally substituted C₁₋₁₅ hydrocarbyl group; z represents an integer from 0-4; w represents an integer from 1-5 and z+w is from 1-5 and x and y each independently represent a non-zero number and the mean sum of x+y is from about 1 to about 6. The above dyes may be in the form of a salt such as their sodium salt. Kenworthy et al. further teach that the above dyes are converted to their purified ammonium salts by filtration and desalination by reverse osmosis. The dissolved sodium salt was converted into the ammonium salt by ion-exchange and the resulting ammonium salt dye was used directly in an ink composition. See col. 2, line 25 – col. 3, line 5, col. 3, line 50 – col. 4, line 23, col. 6, lines 52-57, col. 7, lines 4-6, col. 11, line 60 – col. 12, line

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17 and claims 1, 6, 7, 12 and 13. The ink composition as taught by Kenworthy et al. appears to anticipate the present claims.

The only limitation in the claims not found by the examiner is the total amount of a cation in the ink. However, this limitation is considered inherent because there does not appear to be any reason why the cited reference would not contain an ink composition with applicants claimed amount of cations.

It is the examiners position that by converting the above dyes to their purified ammonium salts by filtration, reverse osmosis and/or ion-exchange the amount of the cations in the ink composition of Kenworthy et al. would also be reduced as claimed by applicants.

Conclusion

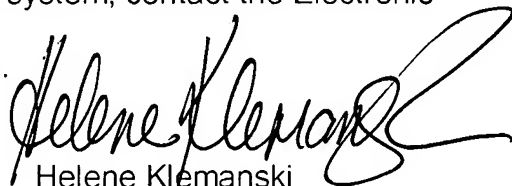
The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Helene Klemanski
Primary Examiner
Art Unit 1755



HK
March 21, 2005